

**REMARKS**

Upon entry of the foregoing amendment, claims 68-120 are pending for the Examiner's consideration, with claims 68, 69, 71, and 72 being the independent claims. Claims 1-67 have all been cancelled herein. Claims 71-120 have been added, and claims 68 and 69 amended. Applicants respectfully submit that the amendments made herein introduce no new matter. In this regard, the Examiner is referred, for example, to paragraphs [00135] to [00149] and Figures 16A-16D and 17A-17C of the application as originally filed.

***I. Rejection Under 35 U.S.C. § 112 ¶ 2***

The Examiner has rejected claim 45 under 35 U.S.C. § 112 ¶ 2 as allegedly being indefinite on grounds of insufficient antecedent basis. Claim 45 has been cancelled herein, thereby rendering this rejection moot.

***II. Rejections Under 35 U.S.C. § 102******A. 35 U.S.C. § 102(e) based on US 2002/0020067***

The Examiner has rejected claims 1, 3, 4-9, 11-14, 16, 18, 24, 25, 27-29, 31, 33-40, 42-44, 46, 48, 50, 56, 57, 59, 60, 61, 63, and 67 under 35 U.S.C. § 102(e) as being anticipated by US 2002/0020067 ("the Silver publication"). All of the rejected claims have been cancelled herein, thereby rendering this rejection moot.

Without conceding the propriety of the rejection made by the Examiner, all of the claims as presented herein explicitly recite the powder capsule as part of the claimed device, and explicitly require a structural and operational relationship between the powder capsule and the longitudinal prong, and other parts of the puncturing device. The Silver publication does not disclose or suggest a device for emitting powder, a powder capsule disposed in the device, nor any structure that can puncture a powder capsule to form a hanging chad as recited in the pending claims. For at least this reason, Applicants respectfully submit that this rejection cannot properly be maintained for the claims as presented herein.

On page 3 of the Office Action, the Examiner asserts that the “device disclosed by Silver *et al.* is inherently able of being used to puncture a powder capsule and for forming a hanging chad in the capsule wall.” Applicants respectfully submit that the Examiner’s assertion is not well reasoned. The device of the Silver publication is a multi-blade (multi-scissor) cutting/chopping device with specially curved blades that make it useful to cut and serve food from a bowl. *See*, Paragraphs [0001] through [0003] of the Silver publication. Applicants respectfully submit that if any of the embodiments of the scissors disclosed in the Silver publication could be used with a powder capsule, the capsule would be either crushed or severed in half as the rotating blades contacted the powder capsule. *See*, for example, Figures 1, 6A, 7A, and 9-12 of the Silver publication. There is no structure disclosed in the Silver publication that can puncture a powder capsule and form a hanging chad as claimed. For this reason as well, Applicants respectfully submit that this rejection cannot properly be maintained for the claims as presented herein.

**B. 35 U.S.C. § 102(e) based on U.S. Patent No. 3,752,027**

The Examiner has rejected claims 1, 14, 31, and 46 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 3,752,027 to Gerber *et al.* (“the Gerber patent”). All of the rejected claims have been cancelled herein, thereby rendering this rejection moot.

Without conceding the propriety of the rejection made by the Examiner, all of the claims as presented herein explicitly recite the powder capsule as part of the claimed device, and explicitly require a structural and operational relationship between the powder capsule and the longitudinal prong, and other parts of the puncturing device. The Gerber patent does not disclose or suggest a device for emitting powder, a powder capsule disposed in the device, nor any structure that can puncture a powder capsule to form a hanging chad as recited in the pending claims. Applicants respectfully submit that if the notch cutting tool for sheet metal disclosed in the Gerber patent could be used with a powder capsule, the capsule would be either crushed or torn into two pieces, and that the cutting tool disclosed in the Gerber patent cannot puncture a powder capsule and form a hanging chad as claimed. For at least these reasons, Applicants respectfully submit that this rejection cannot properly be maintained for the claims as presented herein.

**B. 35 U.S.C. § 102(b) based on U.S. Patent No. 5,676,683**

The Examiner has rejected claims 1, 14, 31, and 46 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,676,683 to Yoon (“the Yoon patent”). All of the rejected claims have been cancelled herein, thereby rendering this rejection moot.

Without conceding the propriety of the rejection made by the Examiner, all of the claims as presented herein explicitly recite the powder capsule as part of the claimed device, and explicitly require a structural and operational relationship between the powder capsule and the longitudinal prong, and other parts of the puncturing device. The Yoon patent does not disclose or suggest a device for emitting powder, a powder capsule disposed in the device, nor any structure that can puncture a powder capsule to form a hanging chad as recited in the pending claims. Applicants respectfully submit that if the tissue penetrating trocar disclosed in the Yoon patent could be used with a powder capsule, the capsule would be either crushed or torn into two pieces, and that the tissue penetrating trocar disclosed in the Yoon patent cannot puncture a powder capsule and form a hanging chad as claimed. For at least these reasons, Applicants respectfully submit that this rejection cannot properly be maintained for the claims as presented herein.

**C. 35 U.S.C. § 102(b) based on U.S. Patent No. 4,617,929**

The Examiner has rejected claims 68-70 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,617,929 to Gill (“the Gill patent”). Independent claims 68 and 69 have been amended herein, thereby rendering this rejection moot.

Without conceding the propriety of the rejection made by the Examiner, claims 68 and 69 have been amended herein to explicitly recite the powder capsule as part of the claimed device, and to explicitly require a structural and operational relationship between the powder capsule and the longitudinal prong, and other parts of the puncturing device. The Gill patent does not disclose or suggest a device for emitting powder, a powder capsule disposed in the device, nor any structure that can puncture a powder capsule to form a hanging chad as recited in the pending claims. Applicants respectfully submit that if the tissue penetrating trocar disclosed in the Gill patent could be used with a powder capsule, the capsule would be either crushed or

torn into two pieces, and that the tissue penetrating trocar disclosed in the Gill patent cannot puncture a powder capsule and form a hanging chad as claimed. For at least these reasons, Applicants respectfully submit that this rejection cannot properly be maintained for the claims as presented herein.

On page 6 of the Office Action, the Examiner asserts that “Gill discloses a cover (72), which is capable of being used to place a powder capsule in for piercing.” The Examiner further asserts that the “cover itself is considered the casing with the aperture, the inside of the cover is considered the cylindrical chamber with straight edges of circular cross-section.” Applicants respectfully submit that the Examiner’s assertions are not well reasoned. Cap 72 cannot reasonably be considered a casing for a powder capsule in a device for emitting powder. As explained in column 5, lines 46-48 of the Gill patent, “a removable rubber or plastic cap 72 is provided to protect the pointed end of the trochar when the appliance is not in use.” The only “aperture” in cap 72 is the opening through which the trocar enters cap 72. As such, Applicants respectfully submit that cap 72 does not contain “at least one aperture configured to emit powder therethrough” as claimed. In addition, Applicants respectfully submit that the inside of cap 72 is not defined by “a *straight wall* of circular cross-section” because of the “notched portion with reduced internal cross-section” relied on by the Examiner for the “ring coupled to the inner surface of the chamber.”

In sum, Applicants respectfully submit that the Gill patent cannot reasonably be said to disclose a device for emitting powder, a casing comprising at least one aperture configured to emit powder therethrough, a powder capsule, or a puncturing device to form a hanging chad in a powder capsule as claimed. For at least all of the foregoing reasons, Applicants respectfully submit that this rejection cannot properly be maintained for claims as presented herein.

### ***III. Rejections Under 35 U.S.C. § 103***

#### **A. 35 U.S.C. § 103(a) based on the Gerber Patent**

The Examiner has rejected dependent claims 15, 17, 19, 47, 49, and 51 under 35 U.S.C. § 103(a) as being unpatentable over the Gerber patent. All of the rejected claims have been cancelled herein, thereby rendering this rejection moot.

Without conceding the propriety of the rejection made by the Examiner, all of the claims as presented herein explicitly recite the powder capsule as part of the claimed device, and explicitly require a structural and operational relationship between the powder capsule and the longitudinal prong, and other parts of the puncturing device. The Gerber patent does not disclose or suggest a device for emitting powder, a powder capsule disposed in the device, nor any structure that can puncture a powder capsule to form a hanging chad as recited in the pending claims. Applicants respectfully submit that if the notch cutting tool for sheet metal disclosed in the Gerber patent could be used with a powder capsule, the capsule would be either crushed or torn into two pieces, and that the cutting tool disclosed in the Gerber patent cannot puncture a powder capsule and form a hanging chad as claimed. For at least these reasons, Applicants respectfully submit that this rejection cannot properly be maintained for the claims as presented herein.

**B. 35 U.S.C. § 103(a) based on the Yoon Patent in View of the Stephens Patent**

The Examiner has rejected dependent claims 22, 23, 54, and 55 under 35 U.S.C. § 103(a) as being unpatentable over the Yoon patent in view of U.S. Patent No. 5,314,417 to Stephens *et al.* ("the Stephens patent"). All of the rejected claims have been cancelled herein, thereby rendering this rejection moot.

Without conceding the propriety of the rejection made by the Examiner, all of the claims as presented herein explicitly recite the powder capsule as part of the claimed device, and explicitly require a structural and operational relationship between the powder capsule and the longitudinal prong, and other parts of the puncturing device. Neither the Yoon nor the Stephens patent discloses or suggests a device for emitting powder, a powder capsule disposed in the device, nor any structure that can puncture a powder capsule to form a hanging chad as recited in the pending claims. Applicants respectfully submit that if the tissue penetrating trocars disclosed in the Yoon and Stephens patents could be used with a powder capsule, the capsule would be either crushed or torn into two pieces, and that the tissue penetrating trocars disclosed in the Yoon and Stephens patents cannot puncture a powder capsule and form a hanging chad as claimed. For at least these reasons, Applicants respectfully submit that this rejection cannot properly be maintained for the claims as presented herein.

**CONCLUSION**

Applicants respectfully submit that the foregoing remarks demonstrate that entry of these amendments places the present application in condition for allowance, or alternatively, in better form for consideration on appeal. All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. It is believed that a full and complete response has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

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Respectfully submitted,

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